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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,491	04/18/2001	Ashit K. Ganguly	IN0931XK	7916

24265 7590 02/24/2004

SCHERING-PLOUGH CORPORATION  
PATENT DEPARTMENT (K-6-1, 1990)  
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EXAMINER

LEWIS, PATRICK T

ART UNIT PAPER NUMBER

1623

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/837,491

Applicant(s)

GANGULY ET AL.

Examiner

Patrick T. Lewis

Art Unit

1623

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-17.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☒ Other: See Continuation Sheet

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Continuation of 3. Applicant's reply has overcome the following rejection(s): provisional rejection of claims 1-5 and 15 under the judicially-created doctrine of obviousness type double patenting over application 09/837,609.


Continuation of 10. Other: Applicant's response has rendered several objections/rejections set forth in Office Action dated July 28, 2003 moot. For the sake of clarity, the examiner is stating the objections/rejections of record herein.

1. The disclosure is objected to because of the following informalities:  
Each sentence/paragraph should end in appropriate punctuation including sentences/paragraphs wherein a figure, table, or scheme is incorporated. Items in a list should be separated by appropriate punctuation. See pages 1, 8, 9, 11, 12, 13, 14, 15, 16, 17, 22, 25, 26, 31, 32, 36, 39, 40, 41, 42, 48, 49, 54, 55, 56, 57, 60, 61, and 62.
2. Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 13, 15, 16, and 28 of U.S. Patent No. 6,277,830 B1. Although the conflicting claims are not identical, they are not patentably distinct from each. Applicant should note that the terminal disclaimer referred to in the Response dated December 22, 2003 is not of record.
3. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.  
In claim 1, lines 11-14, variables R2', R3' and R5' are unclear, ambiguous, and confusing as each of the variables have not been clearly defined. For example, when R2' is R20-(W)x-CO- (not H) the conditions of claim 1 are met; however, R3' and R5' are not defined. The variable "Y" has not been defined (page 97, line 1). The alternate manner in which variables are claimed is unclear, ambiguous, and confusing (page 97, lines 2-3). All claims wherein the variables have not been clearly are indefinite.

Regarding applicant's argument that one skilled in the art would readily ascertain the meaning of variable R2', R3' and R5', the examiner respectfully disagrees. Variables R2', R3' and R5' are not properly defined. Only one variable is necessarily defined.

Applicant's use of the term "heterocyclic" is unclear as heterocyclic compounds incorporate a heteroatom. Applicant's description of moieties incorporated by the term "heterocyclic" (pages 21-22 of instant specification) is inconsistent with the accepted meaning as a heteroatom may not be part of the ring. The incorporation of said term renders all claims in which they appear indefinite.

Regarding applicant's argument that one skilled in the art would be apprised of the scope of the term "heterocyclic" in view of the definition and examples provided, the examiner respectfully disagrees. Applicant has defined the term "heterocyclic" on pages 21-22 of the specification. When variables I and J are -CR60 and -CHR60, respectively, the cyclic structural formula applicant asserts as "heterocyclic" does not conform to the conventional definition of "heterocyclic" as no heteroatom is present. No proviso is provided indicating that variables I and J cannot be -CR60 and -CHR60, respectively, in the cyclic structure.

  
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